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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,153	10/15/2001	Shigeki Enoki	011375	9280

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EXAMINER

KRAMER, JAMES A

ART UNIT PAPER NUMBER

3627

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/976,153	Applicant(s) ENOKI ET AL.	
	Examiner James A. Kramer	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 13-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Action Summary

Claims 1-15 are pending.

Claims 13-15 are newly added.

Claims 13-15 are withdrawn as restricted to a non-elected (original presentation) invention.

Claims 1-12 are rejected under a new grounds of rejection and thus this action is non-final.

Election/Restrictions

Newly submitted claims 13-15 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- I. Claims 1-12, drawn to a POS system.
- II. Claims 13-15, drawn to a method for canceling a transaction.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the POS of invention I can be used to purchase products and therefore can be used in a materially different process.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 13-15 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear from claim 1, where transaction data is stored (i.e. on the POS terminal at which the transaction occurred; on the store server or both).

For example lines 4-6 include a POS terminal with a “means for querying the store server and requesting transaction data relating to a transaction that occurred at another POS terminal”. Since the claims do not include an explicit recitation of the store server querying the POS terminal at which the transaction occurred one is left to assume that the transaction data is stored centrally on the store server. Examiner further notes that support for this interpretation in claim 4.

However, in lines 10-11 the claim recites means “for transferring said transaction cancel instruction to said POS terminal at which said transaction occurred”. In contrast to the earlier made assumption/interpretation, this limitation leads one to assume that transaction data is stored

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locally on each POS. Why would the system send a cancel instruction to the POS terminal unless the data was store on the POS terminal.

Finally, claim 3 seems to indicate that the transaction data is stored both locally at the POS and on the store server. This option is the most puzzling as the claims include a cancel transaction request to the POS but nothing that cancels the transaction on the store server. In such a situation it would appear that the data on the POS terminals would not reconcile to the data on the store server.

For purposes of compact prosecution, Examiner interprets the claim as storing the transaction data in the store server.

Examiner kindly requests Applicant to clarify in the next response where the data is stored. Further Examiner invites Applicant to phone the Examiner in order to discuss the details of this matter in order to ensure proper clarification and correction in the ensuing response.

In addition to the issue discussed above, Examiner further finds the means for language of the limitation on lines 9-11 indefinite. In particular it is unclear whether Applicant wishes there to be a means for receiving and a means for transferring or whether there is only one means that both receives and transfers.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4; 7-8 and 11-12, as interpreted by the Examiner are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers in view of Houvener.

Rogers teaches an electronic registration system for product transactions. Specifically Rogers includes a store server and a plurality of POS terminals (see for example column 2, lines 28-44 and column 3 line 65 through column 4, line 12). Examiner notes that the local transaction database represents Applicant's store server. Further, Rogers' teaching of large chain stores with links to "registers" represents a plurality of registers.

Rogers teaches each of said POS terminals comprises means for transmitting transaction data to said store server as a transaction occurs (see for example column 2, lines 60-67).

Rogers further teaches a means for querying said store server and requesting transaction data relating to a transaction that occurred at another POS terminal with means for instructing said store server to cancel the transaction that occurred at another POS terminal (see for example column 4, lines 8-10).

Rogers teaches a means for executing a transaction cancel instruction received from said store server to cancel a transaction that occurred at said each POS terminal. Examiner notes that Applicant defines in the specification that a cancel transaction includes a "purchase being

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returned by the customer,” see Specification page 1, lines 20-22. Therefore as Rogers teaches processing the return of a product, Rogers includes a “means for executing a transaction cancel instruction received from said store server to cancel a transaction that occurred at said each POS terminal.”

Examiner notes that Rogers does not specifically teach returns are performed at a POS terminal. Rather Rogers teaches them performed at an operator terminal.

Houvener teaches every point-of-sale hardware device in a retail establishment available to accepts returns (see for example column 3, lines 40-50). Examiner notes that one of ordinary skill would recognize this as beneficial for hardware efficiency (i.e. not needing a separate terminal for returns).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the operator terminal of Rogers to be a POS terminal as taught by Houvener in order to provide hardware efficiency within a retail establishment.

With respect to claim 2, Examiner notes that a return is a correction.

With respect to claims 3-4, and 7-8, Examiner notes that the POS's of Rogers include storage means but as interpreted by the Examiner the local transaction database store the POS-by-POS data.

Claims 5-6 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers in view of Houvener as applied to the claims above, and further in view of Uchida.

Rogers and Houvener teach all the claimed limitations except a totalizing means. Uchida teaches electronic cash register system with consolidating means (totalizing). Uchida teaches this means as useful to lessen the labor and time it takes to get information desirable to a store owner/manager (see column 1, lines 35-40).

It would have been obvious to modify the system of Rogers to include a consolidating means as taught by Uchida in order to lessen the labor and time it takes to get information desirable to a store owner/manager.

Response to Arguments

Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (571) 272 6783. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272 6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



James A. Kramer
Examiner
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jak
8/1/06